

**REMARKS**

Amended Claims 1, 10 and 15, and new Claims 20-26, are supported by the description at, for example, the first full paragraph at page 7 of the specification.

No new matter is added.

**I. RESPONSE TO REJECTION UNDER 35 U.S.C. § 102/§ 103**

The final Office Action contains only one rejection. Specifically, Claims 1-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent Nos. 5,527,649 or 5,718,992 (referred to collectively as "Sato").

At lines 8-15 of Section No. 3 on page 3 of the final Office Action, the examiner states that she was not persuaded by either the declaration evidence originally submitted March 2006 or the declaration evidence submitted in October 2006. With respect to the March 2006 declaration evidence, the examiner states:

the samples demonstrating that the optical density is not achieved by the examples of the reference are not persuasive as they all contain carbon black, which the examiner has discussed above, is not required to be present given the teachings of the reference, and that a metal particle only may be chosen from gold, silver, copper, and nickel.

With respect to the October 2006 declaration evidence, the examiner states:

in the samples comprising silver, there are no data points around the upper end of the range (0.9 micron thickness), thus there is a gap from 0.8 to 1.0, and there must be points shown across the claimed range.

Applicants respectfully traverse the present §102/§103 rejection.

There is no *express* disclosure within Sato of the combination of (i) a film thickness of 0.9  $\mu\text{m}$  or less and (ii) an optical density of 3.3 or more, as recited in the present independent claims. As stated in the October 2006 Response, in accordance with the *Atofina* case, the

disclosure of a range of 0.3 to 5 microns in Sato does not constitute a specific disclosure of the endpoints of that range.

With respect to the *inherency* aspect of the §102 anticipation aspect of the present rejection, Applicants have already done more than is required to disprove an inherent disclosure under §102. In this regard, Applicants are not required to compare the claimed subject with embodiments or examples that do not exist in the prior art.<sup>1</sup> By conducting experiments showing that a light-shielding layer prepared using a light-shielding layer coating solution according to Sato (Y-7 from column 16 of Sato) and having a thickness within the presently claimed range of 0.9  $\mu\text{m}$  or less, and submitting the results from the experiments as part of the March 2006 Declaration, Applicants have done more than is required.

It is improper for the examiner to criticize the March 2006 declaration evidence “for all [containing] carbon black.” The March 2006 declaration evidence is supplementary evidence showing that a light-shielding layer prepared using a light-shielding layer coating solution according to Sato (Y-7 from column 16 of Sato), and having a thickness within the presently claimed range of 0.9  $\mu\text{m}$  or less, does not possess an optical density falling within the presently claimed range of 3.3 or more.

The fact of the matter is that none of the examples in Sato has a light-shielding layer having the combination of a film thickness of 0.9  $\mu\text{m}$  or less and an optical density of 3.3 or more, and on this basis alone, any *inherency* position is unfounded.

Moreover, the recitation in Claims 1, 10 and 15 that the average particle size of the metal particles is from 5 to 800 nm further differentiates the presently claimed subject matter from Sato. Sato does not disclose or suggest an average particle size of metal particles being from 5 to 800 nm.

With respect to the §103 obviousness aspect of the present rejection, the presently claimed light-shielding layer achieves unexpectedly superior results with respect to hue and the suppression of the generation of bubbles. As evidence, Applicants submitted on October 10, 2006, a Declaration Pursuant to 37 C.F.R. § 1.132 of co-inventor Akira Hatakeyama. Mr.

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<sup>1</sup> See, *In re Geiger*, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987).

Hatakeyama's Declaration reports experimental results that demonstrate the unexpected superiority of the claimed light-shielding layer. Mr. Hatakeyama's Declaration, together with the other evidence of record, including the experimental results reported in the specification, serve to rebut any alleged *prima facie* case of obviousness.

Also with respect to the §103 obviousness aspect of the present rejection, the average particle size of the metal particles being from 5 to 800 nm creates significant technical advantages for the presently claimed light-shielding layer. As evidence, Applicants are submitting herewith a Declaration Pursuant to 37 C.F.R. § 1.132 of co-inventor Akira Hatakeyama executed on July 13, 2007. Mr. Hatakeyama's July 2007 Declaration, together with the other evidence of record, serves to rebut any alleged *prima facie* case of obviousness.

For the foregoing reasons, Applicants request reconsideration and withdrawal of the present §102/§103 rejection.

## II. CONCLUSION

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the examiner feels may be best resolved through a personal or telephone interview, the examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

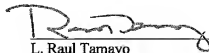
Respectfully submitted,

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Date: July 20, 2007